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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Educational Film Center

Serial No. 74/552,354

Susan Stone Rosenfield and Thomas J. Moore of Bacon & Thomas
for The Educational Film Center.

Esther Borsuk, Trademark Examining Attorney, Law Office 103
(Kathryn Erskine, Managing Attorney).

Before Cissel, Hanak and Quinn, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On July 22, 1994, applicant filed an application to
register the mark "ECONOMICS U\$A" on the Principal Register
for "pre-recorded videocassettes in the field of education
about economics; and pre-recorded videocassettes for use in
telecourses in the field of economics which may be provided
by colleges and other institutions of higher learning," in
Class 9; "printed material including books in the field of
education about economics, books to accompany videocassettes
in the field of education about economics, and books for use
in telecourses in the field of economics which may be

provided by colleges and other institutions of higher learning," in Class 16; and "educational services in the field of economics, that include providing a series of pre-recorded videocassettes and printed material for use in telecourses in the field of economics which may be provided by colleges and other institutions of higher learning; videotape production services in regard to the foregoing," in Class 41. The application was based on applicant's claim of use of the mark in connection with these goods and services in 1983, and use in commerce with them since September 29, 1986.

In addition to raising other issues which were subsequently resolved, including a refusal to register based on the allegation that the mark is merely descriptive of the identified goods and services within the meaning of Section 2(e)(1) of the Act, the Examining Attorney refused registration under Section 2(d) of the Act based on her finding that, as used with the goods and services set forth in the application, applicant's mark so resembles the mark "ECON USA," which is registered¹ for "educational pamphlets concerning economics," that confusion is likely.

Applicant responded by amending the identification of the goods, amending the application to seek registration

¹ Reg. No. 1,155,549, issued on May 26, 1981 to Junior Achievement Inc. Combined affidavit under Sections 8 and 15 was

under the provisions of Section 2(f) of the Act, and submitting the declaration of its president, Stephen Rabin. The amendment listed the goods as "pre-recorded video cassettes in the field of education about economics; and pre-recorded video cassettes for use in telecourses in the field of economics," in Class 9, and "printed material, namely books to accompany video cassettes in the field of education about economics and books for use in telecourses in the field of economics," in Class 16. The references to services in the application as it was filed were deleted.

The Examining Attorney accepted the amended identification of the goods and the amendment claiming distinctiveness, and withdrew the refusal based on descriptiveness. The refusal based on the likelihood of confusion, however, was repeated and made final with the Office Action of August 21, 1995.

Four months later, on December 22, 1995, applicant filed a notice of appeal. Along with the notice of appeal, and still well within the six-month period for responding to the final refusal, applicant filed an appeal brief, attached to which was a copy of the registration file of the mark cited as a bar to the registration of applicant's mark. Applicant explained that on December 15, 1995, it had ordered from the Patent and Trademark Office a certified

filed. The exclusive right to use "USA" apart from the mark as a

copy of the file, but that because of a backlog of such orders in the Office, the order had yet to be filled. Further, applicant advised that it expected to be able to provide the certified copy with its reply brief.

In her brief, the Examining Attorney objected to the Board's consideration of this evidence on the ground that it was not timely submitted. Attached to applicant's reply brief was the certified copy of the registration file that applicant had ordered prior to the filing of its notice of appeal and its appeal brief.

The objection is not well taken under the facts of this case. The issue is not whether the certified copy of the file submitted with applicant's reply brief was timely, because a certified copy was not necessary. Under Trademark Rule 2.122(e), copies of official records of the Office need not be certified in order to be made of record. The issue here is whether the copy submitted on December 22, 1995 was timely. Under Trademark Rule 2.142(d), the record in an application closes with the filing of the notice of appeal. The copy submitted concurrently with the notice of appeal and the appeal brief was accordingly timely.

An oral hearing was conducted at the request of applicant on April 17, 1997.

whole is disclaimed.

Based on careful consideration of the record in this application and the appropriate legal principles and precedents, we hold that the mark applicant seeks to register, as applied to the goods set forth in the application, is not barred from registration by Section 2(d) of the Lanham Act. As is frequently the case in evaluating refusals under this section of the Act, our analysis centers around the similarities between the marks in question and the relationship between the goods on which they are used. In the instant case, although the marks in issue create commercial impressions which are similar in some respects, the record falls short of establishing that the goods set forth in the application are commercially related to the products identified in the cited registration in such a way that confusion is likely to result from the contemporaneous use of both marks.

The marks are not identical, but we find them to be similar in several significant ways. "ECON" is a recognized abbreviation for "economics," and the dollar sign which is substituted for the letter "S" in applicant's mark, while a noticeable feature in the graphic presentation of the mark, is suggestive of financial matters, and would not necessarily be recalled by purchasers who later encounter the registered mark. Further, a person who had some familiarity with the registered mark, upon seeing

applicant's mark, might be likely to assume that the latter is a stylized version of the former. In short, the commercial impressions created by "ECONOMICS U\$A" and "ECON USA" are similar enough that if these marks were used on closely related goods or services, confusion would be likely.

The instant case does not present such a situation, however. The record does not provide a factual basis for concluding that applicant's educational videocassettes and books used in connection with telecourses in the field of economics are commercially related to the "educational pamphlets concerning economics" set forth in the cited registration such that confusion is likely. The channels through which applicant's goods move are different from the ones for the products named in the cited registration. According to the declaration of applicant's president, applicant's tapes and books are purchased by educational institutions as well as individuals and firms in business and industry who seek materials in the field of education about economics. In contrast, the file of the registered mark makes it clear that the goods with which the registered mark are used are pamphlets, described in the application as filed as "mailings to the general public explaining how the free enterprise system functions." Such products are in a different trade channel from the one in which applicant's

goods move. Applicant's tapes and books are only purchased for use in conjunction with enrollment in one of applicant's recorded televised courses of study in economics.

Registrant's pamphlets cannot be used and coordinated with applicant's television courses, according to applicant.

There is no evidence of record that registrant's products move in the same channels of trade as applicant's do.

Moreover, when she was asked at the oral hearing to identify places where or people to whom the goods of both applicant and registrant would be sold, the Examining Attorney could not do so.

As noted above, the registration claims first use in 1977 and applicant began using its mark in 1983. In light of the different trade channels through which these goods travel and the different people to whom they are sold, it is not surprising that applicant's president is not aware of any incidents of actual confusion between these marks during the period of overlapping use.

For the reasons set forth above, the refusal to register is reversed. The application will be forwarded for publication.

R. F. Cissel

E. W. Hanak

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T. J. Quinn
Administrative Trademark Judges,
Trademark Trial & Appeal Board

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